

REMARKS

Independent Claim 5 has been amended to include the salient limitations of now-canceled Claim 7 and defines the invention as a tap dancing shoe including a sole including a front portion, a rear portion, a top surface, and a bottom surface. An upper is secured to the sole and defines a shoe cavity that completely encloses the front portion of the sole. A front tap plate is secured to the bottom surface of the front portion of the sole, and a heel is attached to the bottom surface of the sole. The heel has a bottom, and a rear tap plate is secured to the bottom of the heel. Lastly, a shock absorbing cushion is disposed within the shoe cavity and extends from the front portion of the top surface of the sole to the rear portion of the top surface of the sole. The shock absorbing cushion is permanently secured to the top surface of the sole.

The Stafford reference is clearly and unambiguously directed toward the manufacture of women's strap shoes, i.e., shoes having a plurality of spaced upper shoe segments. In particular, the Stafford reference recognizes that it is "difficult to attach spaced upper shoe segments between a shoe insole and outsole so as to provide a comfortable and good-looking shoe with the spaced upper shoe segments securely retained in place." Although the Stafford reference does state that "the specific design of the circumferentially spaced upper elements or straps 12 and the shoe upper heel area 14 forms no part of the present invention and may be varied to suit the aesthetic or design appearance of the shoe that is desired," it is nonetheless a requirement of the Stafford reference that the shoe have a plurality of such straps.

The Stafford reference is non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention. As set forth in Section 2141.01(a) of the MPEP, a reference must either be (1) in the field of the applicant's endeavor or (2) reasonably pertinent to the particular problem with which the inventor was concerned. With respect to the latter test, a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

With respect to the first leg of this test for analogous art, the field of the Stafford reference (namely, strap shoes; open toe, side and heel shoes; and other open work shoes) is quite different from the field of the claimed invention (namely, tap dancing shoes). The claimed invention is specifically directed toward a tap dancing shoe that includes a sole and an upper that is secured to the sole and defines a shoe cavity that completely encloses the front portion of the sole. Not only is the Stafford reference not directed toward the claimed tap dancing shoe, the basic structure of the Stafford shoe is quite different from the claimed invention. Thus, the field of the Stafford reference is clearly not within the field of the claimed invention.

With respect to the second leg of this test for analogous art, the problem addressed by the Stafford reference (namely, the “[s]ubstantial manufacturing difficulties, with attendant economic and aesthetic disadvantages, encountered in the manufacture of women's strap shoes; open toe, side and heel shoes; and other open work shoes”) is quite different from the problems addressed by the claimed invention (namely, reducing the magnitudes of the repetitive stresses that can be applied to the feet, knees, and the overall legs of a dancer during tap dancing). Thus, the Stafford reference is clearly non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention.

Additionally, dependent Claim 9 recites that the shock absorbing cushion includes a layer of a cushioning material that is thicker at the front portion of the sole than at the rear portion of the sole. The Stafford reference does not show or suggest this structure. Rather, the Stafford reference discloses a cushion insole device 22 having a generally rigid upper layer 24 and a resilient and compressible lower layer 26. The generally rigid upper layer 24 includes relatively thicker and rigid heel and toe portions 36, 38 that are interconnected to an intermediate relatively thinner and flexible portion 40. Thus, as clearly shown in Fig. 7, the compressible lower layer 26 of the cushion insole device 22 is, in fact, relatively thin in the heel and toe portions 36, 38 in comparison with the intermediate portion 40. Thus, the Stafford reference teaches away from the subject matter recited in Claim 9.

Lastly, new dependent Claim 12 recites that the shock absorbing cushion includes a bottom layer that is formed from a foamed polymeric material and a top layer that is formed from a textured fabric material. None of the art of record appears to disclose this structure.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard S. MacMillan", written over a horizontal line.

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